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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,759	08/16/2005	Gary Mark Coppola	4-32859A	1610

75074 7590 11/04/2008

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EXAMINER	
MABRY, JOHN	

ART UNIT	PAPER NUMBER
1625	

MAIL DATE	DELIVERY MODE
11/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,759	COPPOLA ET AL.	
	Examiner	Art Unit	
	John Mabry, PhD	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-9, 12-13, 18-20, 22 and 25-33* is/are pending in the application.

4a) Of the above claim(s) *25-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-9,12,13,18-20,22 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment(s)

Applicant's response on August 11, 2008 filed in response to the Office Action dated April 10, 2008 has been received and duly noted.

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 7-9, 12-13, 18-20, 22 and 33 are pending and rejected.

Claims 1-6, 10-11, 14-17, 21, 23-24 and 34-39 have been cancelled.

Claims 25-32 are directed to non-election subject matter.

Response to rejections:

35 USC § 112 Rejection(s)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The 112-1st rejection of claims 7-9, 12-13, 18-20, 22 and 33 regarding the scope of enablement for R1-R2 and R6-R9 have not been overcome in view of Applicants amending the claims. As described in previous Non-Final Office Action, R1-R2 and R6-R9 is not enabled to be the entire scope as claimed (more specifically the terms

optionally substituted, heterocyclic, aryl and heteroaryl groups). Additionally, Examiner notified Applicant that instant claims were only enabled where R13 and R14 being only H – not the full scope as claimed.

Applicant argues that there is "tremendous" support exists for heterocyclic, aryl and heteroaryl groups as claims. However, Examiner would like to point Applicant definition of such claimed terms. According the Specification definition of said terms as defined in the Specification (pages 5-7) is as follows:

> The term "aryl" refers to monocyclic or bicyclic aromatic hydrocarbon groups having 6 to 12 carbon atoms in the ring portion, such as phenyl, naphthyl, tetrahydronaphthyl, biphenyl and diphenyl groups, each of which may optionally be substituted by one to four substituents such as alkyl, halo, hydroxy, alkoxy, alkanoyl, alkanoyloxy, optionally substituted amino, thiol, alkylthio, nitro, cyano, carboxy, carboxyalkyl, alkoxycarbonyl, alkylthiono, alkyl- and arylsulfonyl, sulfonamido, heterocycloyl and the like.

The term "heterocyclyl" or "heterocyclo" refers to an optionally substituted, fully saturated or unsaturated, aromatic or nonaromatic cyclic group, for example, which is a 4- to 7-membered monocyclic, 7- to 12-membered bicyclic, or 10 to 15 membered tricyclic ring system, which has at least one heteroatom in at least one carbon atom-containing ring. Each ring of the heterocyclic group containing a heteroatom may have 1, 2 or 3 heteroatoms selected from nitrogen atoms, oxygen atoms and sulfur atoms, where the nitrogen and sulfur heteroatoms may also optionally be oxidized. The heterocyclic group may be attached at a heteroatom or a carbon atom.

Exemplary monocyclic heterocyclic groups include pyrrolidinyl, pyrrolyl, pyrazolyl, oxetanyl, pyrazolinyl, imidazolyl, imidazolinyl, imidazolidinyl, oxazolyl, oxazolidinyl, isoxazolinyl, isoxazolyl, thiazolyl, thiadiazolyl, thiazolidinyl, isothiazolyl, isothiazolidinyl, furyl, tetrahydrofuryl, thienyl, oxadiazolyl, piperidinyl, piperazinyl, 2-oxopiperazinyl, 2-oxopiperidinyl, 2-oxopyrrolodinyl, 2-oxoazepinyl, azepinyl, 4-piperidonyl, pyridyl, pyrazinyl, pyrimidinyl, pyridazinyl, tetrahydropyranyl, morpholinyl, thiamorpholinyl, thiamorpholinyl sulfoxide, thiamorpholinyl sulfone, 1,3-dioxolane and tetrahydro-1,1-dioxothienyl, and the like.

Exemplary bicyclic heterocyclic groups include indolyl, benzothiazolyl, benzoxazolyl, benzothienyl, quinuclidinyl, quinolinyl, tetrahydroquinolinyl, decahydroquinolinyl, isoquinolinyl, tetrahydroisoquinolinyl, decahydroisoquinolinyl, benzimidazolyl, benzopyranyl, indolizinyl, benzofuryl, chromonyl, coumarinyl, benzopyranyl, cinnolinyl, quinoxalinyl, indazolyl, pyrrolopyridyl, furopyridinyl (such as furo[2,3-c]pyridinyl, furo[3,2-b]-pyridinyl] or furo[2,3-b]pyridinyl), dihydroisoindolyl, dihydroquinazolinyl (such as 3,4-dihydro-4-oxo-quinazolinyl) and the like.

Exemplary tricyclic heterocyclic groups include carbazolyl, benzindolyl, phenanthrolinyl, acridinyl, phenanthridinyl, xanthenyl and the like.

The term "heterocyclyl" includes substituted heterocyclic groups. Substituted heterocyclic groups refer to heterocyclic groups substituted with 1, 2 or 3 substitutents selected from the group consisting of the following:

(a) alkyl;
(b) hydroxy (or protected hydroxy);
(c) halo;
(d) oxo, i.e., =O;
(e) optionally substituted amino, alkylamino or dialkylamino;
(f) alkoxy;
(g) cycloalkyl;
(h) carboxy;
(i) heterocyclooxy;
(j) alkoxycarbonyl, such as unsubstituted lower alkoxycarbonyl;
(k) mercapto;
(l) nitro;
(m) cyano;
(n) sulfamoyl or sulfonamido;
(o) alkanoyloxy;
(p) aroyloxy;
(q) arylthio;
(r) aryloxy;
(s) alkylthio;
(t) formyl;
(u) carbamoyl;
(v) aralkyl; and
(w) aryl substituted with alkyl, cycloalkyl, alkoxy, hydroxy, amino, acylamino, alkylamino, dialkylamino or halo.

Applicant states that Examiner lists 12 different heterocyclic, aryl and heteroaryl groups. However, the Examiner maintains that since there are 12 different heterocyclic, aryl and heteroaryl groups are represented that does not mean that Applicant is enabled for the

entire scope of the claims as defined above. An appropriate action is requested to overcome this rejection.

Applicant also attempts to cast doubt that Dr. Dorwald's comment on the unpredictability of organic chemistry. Applicant asserts that industrial chemist do not spend most of there time "finding out what went wrong and why". Examiner strongly disagrees. Industrial organic chemists, such as discovery organic chemist, are guided by such inquiries on a daily basis. Additionally, Dr. Dorwald's comment is not just directed towards research in the "academic world" as Applicant has asserted. Actually, since 1995, Dr. Dorwald has held position as medicinal chemist at Novo Nordisk® - a world leading healthcare company - certainly not an academic research laboratory.

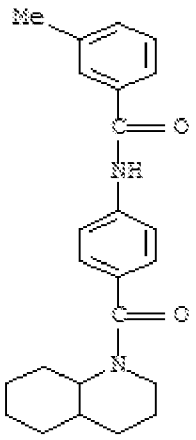
Claim Rejections - 35 USC § 102

Claims 1, 2, 3, 7, 8, 9, 11 and 33 rejected under 35 U.S.C. 102(b) as being anticipated by Luts (J. Pharm. Sci. 1971, 60, 1409-1411) have been withdrawn due to Applicant's arguments.

Claims 1, 2, 3, 18, 19, 20, 22 and 33 rejections are withdrawn under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al (WO 2003029199 - US equivalent 2004/0259912 A1), but due to Applicant's amendments said claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (WO 2003029199 - US equivalent 2004/0259912 A1). This rejection is described in detail below under "*35 U.S.C. 103(a)*".

Claims 1, 2, 3, 7, 8, 9, 11 and 33 rejections are maintained under 35 U.S.C. 102(b) as being anticipated by Ogawa et al (WO 9401113 A1).

Ogawa et al clearly discloses compounds and pharmaceutical compositions of Formulas I and Ia wherein R13 and R14=H, W=NR5C(O)R6 wherein R5=H and R6=methylphenyl and R1 and R2=H (see compound 2-149, page 146).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

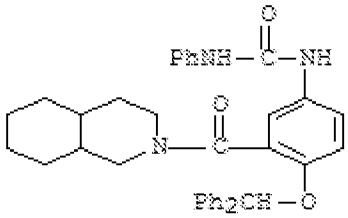
The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating.

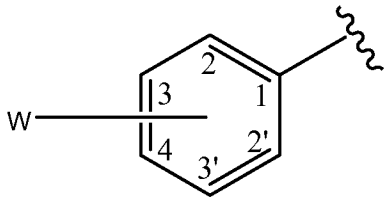
Claims 18, 19, 20 and 33 rejections are withdrawn under 35 U.S.C. 103(a) as being obvious over Matsumoto et al (WO 2003029199 - US equivalent 2004/0259912 A1).

The instant application claims compounds and pharmaceutical compositions of Formulas I and Ih wherein R1=H, W=NR5Z wherein R5=H and Z=C(O)NHPh and R2=Ph2CHO- (a substituted alkoxy).

Matsumoto discloses compounds and pharmaceutical compositions of Formulas I and Ih wherein R1=H, W=NR5Z wherein R5=H and Z=C(O)NHPh and R2=Ph2CHO- (a substituted alkoxy) (see Example 396, Table 1, page 117 and paragraph 1682, page 65).



Matsumoto differs from the instant application at the position of W: Applicant's -NR5Z at the 3'-position versus Applicant's 4-position. These are positional isomers.



There is little difference between the NR5Z substituent being at the 3'-position as compared at the 4-position on the claimed structure of formula Ia. It is well established that position isomers are prima facie structurally obvious even in the absence of a teaching to modify. The isomer is expected to be prepared by the same method and to have generally the same properties. This expectation is then deemed the motivation for preparing the position isomers. This circumstance has arisen many times. See: *Ex parte Englehardt,* 208 USPQ 343, 349; *In re Mehta,* 146 USPQ 284, 287; *In re Surrey*, 138 USPQ 67; *Ex Parte Ullyot,* 103 USPQ 185; *In re Norris,* 84 USPQ 459; *Ex. Parte Naito,* 168 USPQ 437, 439; *Ex parte Allais,* 152 USPQ 66; *In re Wilder,* 166 USPQ 545, 548; *Ex parte Henkel,* 130 USPQ 474; *Ex parte Biel,* 124 USPQ 109; *In re Petrzilka,* 165 USPQ 327; *In re Crownse,* 150 USPQ 554; *In re Fouche,* 169 USPQ 431; *Ex parte Ruddy,* 121 USPQ 427; *In re Wiechert,* 152 USPQ 249, *In re Shetty,* 195 USPQ 753; *In re Jones,* 74 USPQ 152, 154. There may be others as well. Thus, said claims are rendered obvious by Matsumoto et al.

For example, "Position isomerism has been used as a tool to obtain new and useful drugs" (*Englehardt*) and "Position isomerism is fact of close structural similarity" (*Mehta*, emphasis in the original). Note also *In re Jones,* 21 USPQ2d 1942, which states at 1943 "Particular types or categories of structural similarity without more, have, in past cases, given rise to prima facie obviousness"; one of those listed is "adjacent

homologues and structural isomers". Position isomers are the basic form of close "structural isomers." Similar is *In re Schechter and LaForge,* 98 USPQ 144, 150, which states "a novel useful chemical compound which is homologous or isomeric with compounds of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compounds." Note also *In re Deuel* 34 USPQ2d 1210, 1214 which states, "Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds…a known compound may suggest it analog or isomers, either geometric (cis v. trans) or position isomers (e.g. *ortho v. para*)." See also MPEP 2144.09, second paragraph. Further, the reference provides for the ring being substituted in any position.

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" KSR, 550 U.S. at___, 82 USPQ2d at 1396. Exemplary rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP § 2143 for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness. See also MPEP § 2144- §2144.09 for additional guidance regarding support for obviousness determinations.

The aforementioned reasons above describe rationales that support a conclusion of obviousness based upon the KSR International Co. *v.* Teleflex Inc. decision. Letters (A) - (E) rationale is supported above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/
Examiner
Art Unit 1625

/Rita J. Desai/
Primary Examiner, Art Unit 1625